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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 1746

NATIONAL GYPSUM COMPANY AND PLAZA PLASTERING COMPANY,

Petitioners,

vs.

UNITED STATES GYPSUM COMPANY,

Respondent.

PETITIONERS' REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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May 28, 1971.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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Questions 1 and 2.

Respondent's *sole* ground of opposition to the petition is that Mackey's work, while more than one year prior to the application, was after the date of the patentee's invention and therefore should not be considered as prior art under 35 U. S. C. § 103. Respondent is wrong. Its date of the claimed invention has *not* been shown to be prior to Mackey's work, and even if it had, the date of invention is *totally irrelevant* to the questions here presented.

Respondent's position represents an instance in which the enactment of 35 U. S. C. § 103 has added confusion rather than clarity to the law. Under the former Act (R. S. 4886), where obviousness was not set out as a separate section,

it was clear that a disclosure more than one year before the filing of the patent application did not have to be a full anticipation to bar the patent.* If the common law requirement of "invention" over what was disclosed was not present, the patent was denied. The relevant date for the determination of "invention" was one year prior to the date of filing, not the alleged date of invention.

The enactment of 35 U. S. C. § 103 did not change this law, as respondent is urging. The fallacy of respondent's position has been thoroughly exposed in the excellently developed opinion, *Application of Foster*, 343 F. 2d 980, 989 (C. C. P. A., 1965), *cert. den.*, 383 U. S. 966 (1966). There the same contention was made as is made here by respondent. The Court held that in determining *obviousness* from Section 102(b) prior art:

> "*the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention."
>
> * * * * *
>
> "The wrong in such a construction of the statute—beside giving it a meaning that was never intended—is that it permits an inventor to sleep on his rights more than a year after the invention has become entirely obvious to the public, whereby the public has potential possession of it, and still obtain a patent which will take the invention from the public, a result Congress could not possibly have intended in view of its express indication that section 102(b) is merely a continuation of the prior law."

It is just this wrong that has been permitted in this case and which has resulted in petitioners' being prohibited in

* This application was filed before but issued as a patent after the enactment of 35 U. S. C. § 103.

the future from continuing the very activity that Mackey was conducting and disclosing to the art more than one year before U. S. G. sought to monopolize that activity by filing a patent application.

Application of Foster is the leading case on this point. It has been followed in *Application of Bergstrom,* 427 F. 2d 1394, 1399 (C. C. P. A., 1970); *Application of Hassler,* 347 F. 2d 911, 912, 920 (C. C. P. A., 1965); and, in principle, in *Package Devices, Inc.* v. *Sun Ray Drug Co.,* 432 F. 2d 272, 275 (3rd Cir., 1970), *cert. den.,* ..... U. S. ....., 28 L. Ed. 2d 239 (1971), as well as in *Winchester Carton Corp.* v. *Standard Box Co.,* 294 F. Supp. 1207, 1213-14 (D. Mass. 1969).

The above cases show that it is respondent's position that is absurd, not petitioners. Respondent's position undermines these cases, thereby creating a more lax standard of invention in the federal courts than in the Patent Office. Indeed, respondent's brief in opposition, which argues for a different meaning of "prior" in Sections 102(b) and 103, constitutes an additional reason why the writ should be granted in this case.

Even if U. S. G. were permitted to retreat to its alleged date of invention it would be no better off. It says its invention was "made" February 7, 1947, relying upon a written statement of the patentee bearing that date (Brief, pp. 2-3).

An invention is deemed "made" within the meaning of 35 U. S. C. § 103 when the patent application is filed. The burden of establishing an earlier date rests with the patentee and the degree of proof required is of the same strictness as that required to invalidate a patent for prior use. U. S. G. has not even accepted this burden, much less carried it.

The document relied upon to support the February 7, 1947, date of invention does *not* show the invention claimed

by the patent, nor the *making* of *any* invention. It is merely a statement by the alleged inventor that tape holes "from below 1/64" dia. up to the size of the present holes [the prior art punched holes of 0.0625 inches] *or larger*"* could be made by spark perforation. This document *at most* discloses a spark perforated tape *per se,* which the Patent Office held to be unpatentable.**

Questions 1 and 2 are properly and undisputably raised by the facts of this case.

U. S. G. also erroneously states (Brief, p. 3) that petitioners do not attack the adjudication below that the Mackey work did not constitute a public use or sale under 35 U. S. C. § 102(b). In the petition (pp. 2 and 9) it was specifically pointed out that the lower courts' holdings had resulted in the anomolous situation where U. S. G. had been permitted to monopolize the very activity which Mackey had been engaged in more than a year prior to the filing of U. S. G.'s patent application. It is axiomatic that that which infringes if later anticipates if earlier, yet by holding that Mackey's activity was not a bar, the courts below have thwarted that axiom.

Question 3.

U. S. G. says that question 3 has already been decided by this Court in *Aro Manufacturing Co., Inc.* v. *Convertible Top Replacement Co., Inc.* (Aro II), 377 U. S. 476, 487-88 (1964). The question was *not* decided, or even considered by this Court in Aro II.

As shown by footnote 7 which was carefully *omitted*

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* Emphasis added.

** U. S. G. would also have this Court believe that the earliest date for Mackey's work relied upon was the "middle of 1948" (Brief, p. 2). This ignores the Court of Appeals' own statement that his work began in 1946 or 1947 (prior to U. S. G.'s work), see App. 11.

from the quoted passage at page 4 of U. S. G.'s brief, the fact in Aro II was that:

> "7. Aro's factory manager admitted that the fabric replacements in question not only were specially designed for the Ford convertibles but would not, to his knowledge, fit the top-structures of any other cars."

Thus, in Aro II, this Court found there were *no* noninfringing uses and accordingly did not reach the question presented by this petition, namely, the proper legal standard by which "substantial" noninfringing uses are to be determined.

Respectfully submitted,

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